

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Katsunobu HAYASHI

Confirmation No.: 7831

Appl. No.: 09/683,829

Tech. Center: 3694

Filed : February 20, 2002

Examiner: Mary Da Zhi Wang CHEUNG

For : COMPENSATION CONTRACT SUPPORTING SYSTEM, METHOD FOR
SUPPORTING COMPENSATION CONTRACT, AND PROGRAM THEREOF

DECLARATION BY JIAXIAO ZHANG IN SUPPORT OF RENEWED PETITION
UNDER 37 C.F.R. 1.181
FOR WITHDRAWAL OF HOLDING OF ABANDONMENT

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby declare that:

1. I am currently employed as a Patent Agent with an Intellectual Property Law firm in Alexandria, Virginia.

2. I started working as an Office Manager with the firm of HersHKovitz & Associates, LLC (hereinafter "the Firm") on September 10, 2007, and continued working there until May 16, 2008. I normally worked on patent matters including docketing. As such, I helped the Firm in acquiring the PROLAW docketing system, setting up the PROLAW docketing

system, as well as making entries into the PROLAW docketing system. Therefore, I am very familiar with this docketing system.

3. When an e-mail notification of an Office Action was received by the Firm, I printed out a copy of the Office Action, and I matched the Office action with the respective paper file in order to have the Action docketed and have me or another member of the staff of the Firm prepare a reporting letter of the Office Action to the client for review by one of the patent attorneys or agents in the Firm. While I am not working at the Firm at this time, I was shown the file of the present application and saw that there are no records in the file of the above-captioned application with respect to the Office Action dated March 18, 2008 except for the copy that was attached to the Notice of Abandonment bearing an electronic Notification date of October 8, 2008. The Notice of Abandonment bears a date-stamp of October 8, 2008 with the initials of an employee of the Firm. To the best of my knowledge, I do not recall seeing this Office Action in the March 2008 time frame.

4. Docketing in PROLAW consists of selection of the type of Office Action and an entry of the date of the Office Action. The PROLAW docketing software would then automatically compute the initial response due date and each subsequent monthly due date until the maximum 6 month inextendible deadline. Selection of a pre-created custom event and entry of the date of receipt of the Office Action caused a second set of entries to be made; the PROLAW docketing software would then automatically compute the due date for

forwarding the Office Action to the client (3 days after receipt), the due date for an analysis of the Office Action for those clients who typically requested a detailed analysis (one month after receipt), and an inquiry as to whether we received instructions from the client (two months after receipt of the Office Action).

5. In addition to the PROLAW docket system, the Firm used the Yahoo calendar system as a back-up to the PROLAW docket system.

6. My daily docketing routine was to print out a copy of that day's activities as they appeared in the PROLAW docket system and the back-up Yahoo calendar system. I would then pull all the cases that had docket entries for that day, and go over the docket entries with Dinh Nguyen, one of the patent attorneys at the Firm. In order to ensure that no date was missed, once I completed the docket review with Mr. Nguyen, key dates would be discussed with Abe Herskovitz, the head of the Firm. In addition to docketing new Office Actions in the PROLAW docket system, I would manually annotate the Yahoo docket print-out with the appropriate dates for forwarding the Office Action to the client (3 days after receipt), the due date for an analysis of the Office Action for those clients who typically requested a detailed analysis (one month after receipt), and an inquiry as to whether we received instructions from the client (two months after receipt of the Office Action). I would then give a copy of the annotated Yahoo calendar sheet to Mr. Herskovitz for updating the Yahoo calendar system.

7. To the best of my knowledge and recollection, I processed all e-mails received

from the USPTO in the manner described above. On rare occasions, due to e-mail problems such as an e-mail being sent directly to the Firm's junk e-mail box or other folders, we were unaware of a PTO e-mail relative to an Office Action. In those rare situations, the USPTO would send us a post card reminder that the Private PAIR records were not reviewed for that Office Action during the period in question. I have no recollection of having received a USPTO postcard reminder of this type for this case. Had I received one, I would of course have accessed private PAIR at that point and would have followed the steps described above. The post card would have been date stamped and placed in the applicable file.

8. I have been informed that Exhibit A is a copy of the Firm's records that was printed out by another employee of the Firm (with initials CGV) after my departure, which is a PROLaw system docket specifically for the application at issue (attorney's docket number P13205). If the Office Action at issue had been received, I would have made entries in Exhibit A to show that for attorney docket number P13205, an Office Action dated March 18, 2008 was received, which would have populated entries identical to the ones that were populated as a result of the entries made by employee CGV on November 13, 2008. The entry in row five on this docket report, which shows an Office Action date of March 18, 2008, was apparently entered by employee CGV of the Firm with her annotation that the entry was made on November 19, 2008. I have been informed that the docket report was updated upon receiving the Notice of Abandonment and obtaining a copy of the Office

Action thereafter.

9. An entry made into PROLAW, even after the deadline, would result in the “Event type” column being automatically updated by the PROLAW system by populating those fields with event types such as “Response to Final Office Action due,” “Response to Office Action filed,” “Notice of Appeal or Request for Continued Examination,” etc. Again, these events would have been automatically generated in the docket print-out of Exhibit A after an employee had updated the docket upon receiving the Notice of Abandonment and entered the information regarding the Office Action on November 19, 2008, as I have been informed. In this type of situation, there would be no date entered in the “Completed Date” column for these events because the docket event was not completed.

10. Exhibit B is a print-out of the PROLAW records of all activities for a given time period. I have been informed that Exhibit B, which was printed out by another employee of the Firm after my departure and was annotated to delete specific entries relative to other docket numbers Exhibits, is a PROLAW docket report for the months of March (starting on March 17, 2008), April, May, June, July, August and September (up to September 28, 2008). If the Office Action at issue had been received, I would have made entries that would have appeared in Exhibit B for attorney’s docket number P13205, such as “Detailed Analysis of the Office Action,” “Response to Office Action due,” “Reminder sent to Client regarding Office Action,” “Instructions received from Client?,” “Detailed Analysis

sent to client?," etc. As can be seen from Exhibit B, no such indications or entries were made by me for P13205.

11. Exhibit C is a copy that was shown to me as a print-out of the Yahoo calendar for the week of March 18, 2008. I confirm that this is the type of Yahoo calendar print-out that was in use in March 2008, and that the absence of any entries is consistent with an indication that the Office Action of March 18, 2008 was not received, or if it was received, that the Action had been reported to the client (which would have resulted in deletion of that entry).

12. Exhibit D is a copy that was shown to me of a print-out of the Yahoo calendar with a query for any entry related to Docket No. P13205. I confirm that this is the type of Yahoo calendar print-out that would indicate all docketed entries for Docket No. P13205. The absence of an entry related to the Office Action in question indicates that the Office Action was never docketed in the Yahoo calendar or that a response had already been filed (which would have resulted in deletion of that entry).

13. I have reviewed copies shown to me of the records used by the Firm, where the Office Action of March 18, 2008 would have been entered in the PROLAW docket system had it been received, labeled as Exhibit A and Exhibit B in the Renewed Petition, as well as well as the Yahoo calendar print-out for the relevant dates, as shown in Exhibit C and Exhibit D, and hereby state that they appear to be accurate.

14. In order to refresh my recollection of the events related to the above-captioned application, I visited the Firm on December 8, 2008 to review the physical file and the PROLAW docket system pertaining to the file.

15. Exhibit E is a copy of the PROLAW report which was attached to the physical file. As explained in paragraph 16 below, that report appears to have been generated by an employee of the Firm on June 5, 2008 and does not reflect receipt of the Office action dated March 18, 2008.

16. Exhibit F is a print-out of a screen capture which I made on December 8, 2008 from the PROLAW docketing software. That screen shot is based on my search for matter number P13205 and confirms a June 5, 2008 “opened date” for this matter. The screen shot in the middle of Exhibit F shows the “Events Audit Trail” for the 3/18/2008 Office Action. The Audit Trail indicates that the 3/18/2008 event was added on 11/13/2008.

17. Based on my review of the Firm’s physical file and the PROLAW records, it appears that the Office action of March 18, 2008 was not printed out by the Firm until October 8, 2008 when the Notice of Abandonment was printed out. Additionally, my review of the Firm’s physical file fails to reveal receipt of a postcard making reference to an Office action dated March 18, 2008.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

December 8, 2008


Jiajiao Zhang